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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/518,464	03/03/00	FEILER	L HW/P-21988/A

000324  
CIBA SPECIALTY CHEMICALS CORPORATION  
PATENT DEPARTMENT  
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IM52/0201

EXAMINER
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SANDERS, K	PAPER NUMBER
ART UNIT	

1714  
DATE MAILED:

02/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

**09/518,464**

Applicant(s)

**Feiler et al**

Examiner

**Kriellion A. Sanders**

Group Art Unit

**1714**☐ Responsive to communication(s) filed on \_\_\_\_\_☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**☒ Claim(s) 1-15 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.☐ Claim(s) \_\_\_\_\_ is/are rejected.☐ Claim(s) \_\_\_\_\_ is/are objected to.☒ Claims 1-15 are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been☐ received.☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☐ Notice of References Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4, drawn to a benzofuran-2-one compound, classified in class 549, subclass 307.
  - II. Claims 5-8, drawn to a process of making a benzofuran-2-one compound, classified in class 549, subclass 307.
  - III. Claims 9, drawn to an aminohydroxy compound, classified in class 549, subclass 300+.
  - IV. Claim 10, drawn to a process for making an aminohydroxy compound, classified in class 549, subclass 300+.
  - V. Claim 11, drawn to a process for making a compound of claim 1, classified in class 549, subclass 300+.
  - VI. Claim 12, drawn to a composition, classified in class 252, subclass 401+.
  - VII. Claim 13, drawn to a composition, classified in class 524, subclass 11.
  - VIII. Claim 14, drawn to a process for making a compound, classified in class 549, subclass 300+.
  - IX. Claim 15, drawn to a process for making ink, classified in class 106, subclass 100+.

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2. The inventions are distinct, each from the other because of the following reasons: Inventions I, III, VI, VII or IX and any one of II, IV, V, VIII or IX are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case The product could have been made by a materially different process as is evidenced by applicant's claims which include five distinct processes and as is evidenced by the patent to Nesvadba et al, U.S. Patent No. 5,614,572 at col. 25, line 2 through col. 26, line 19.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Claims 1, 12, 13 and 15 are generic to a plurality of disclosed patentably distinct species comprising benzofuran-2-ones and products thereof. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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5. A telephone call was not made to request an oral election to the above restriction requirement, due to the complexity of the art involved.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

7. The inventions are distinct, each from the other because of the following reasons: Any inquiry concerning this communication or earlier communications from the examiner should be directed to K. Sanders whose telephone number is (703) 308-2435.

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A handwritten signature in black ink, reading "Kriellion Sanders". The signature is written in a cursive style with a long, sweeping horizontal line at the end.

ks

January 31, 2001

Kriellion Sanders

Primary Examiner

AU 1714